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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,911	09/21/2001	Hiroshi Takahashi	209560US2DIV	3774

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2622

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,911

Applicant(s)

TAKAHASHI, HIROSHI

Examiner

Cheukfan Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 18-26, 28-36, 38-47, 49-57, 59-65, 68-70, 80-94 and 97-104 is/are allowed.
- 6) ☒ Claim(s) 66, 67 and 71-78 is/are rejected.
- 7) ☒ Claim(s) 17, 27, 37, 48, 58, 79, 95 and 96 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 08/565,296.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 21 Dec. 2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-104 are pending. Claims 1, 11, 22, 32, 42, 53, 63-71, 80, and 89 are independent.

2. The claims 17, 27, 37, 48, 58, 95, and 96 are objected to for the following reasons:

Claim 17 should depend on claim 16, or else "said external memory device" lacks antecedent basis.

Claim 27 should depend on claim 26.

Claim 37 should depend on claim 36.

Claim 48 should depend on claim 47.

Claim 58 should depend on claim 57.

Claim 95 should depend on claim 89, not on claim 88, or else, claims 95 and 86 are redundant limitation for independent claim 80.

Claim 96 is objected to as being dependent upon the objected claim 95.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 66 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,323,963. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason given below.

Claim 66 claims a method corresponding to patent apparatus claim 1. All the three means of the patent have functional limitations as the functional limitations of the corresponding method steps of claim 66. With the patent apparatus claim 1, one of ordinary skill in the art would have known how to derive the claim 66 method from the patent claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a method from the patent apparatus claim 1.

5. Claim 67 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,798,841. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason given below.

Claim 67 claims a method corresponding to patent apparatus claim 1. All the three means of the patent have functional limitations as the functional limitations of the corresponding method steps of claim 67. With the patent apparatus claim 1, one of ordinary skill in the art would have known how to derive the claim 67 method from the

patent claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a method from the patent apparatus claim 1.

6. Claims 71-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,281,990. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason given below.

Claim 71 claims a method corresponding to patent apparatus claim 1. All the three means of the patent have functional limitations as the functional limitations of the corresponding method steps of claim 71. With the patent apparatus claim 1, one of ordinary skill in the art would have known how to derive the claim 71 method from the patent claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a method from the patent apparatus claim 1.

Claims 72-78 correspond to patent claims 2, 4, 5, 6, 3, 7, and 8, respectively. These claims are rejected for the same reasons of obviousness given for claim 71.

7. Claim 79 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 1-16, 18-26, 28-36, 38-47, 49-57, 59-65, 68, 69, 70, 80-94, and 97-104 are allowed.

9. The following is an examiner's statement of reasons for allowance:

The present application has a U.S. effective filing date of Nov. 27, 1995 and a foreign priority date Nov. 28, 1994.

Independent claims 1, 11, 22, 32, 42, 53, 63-65, 80, and 89 each claim image size changing means or size changing step for changing the size of the book image for storage in a specific manner claimed. This feature in combination with other limitations of any of the claims is not taught by the prior art of record.

Dependent claims 2-10, 12-16, 18-21, 23-26, 28-31, 33-36, 38-41, 43-47, 49-52, 54-57, 59-62, 81-88, 90-94, and 97-104 are allowable for the reasons given for their independent claims.

Dependent claim 79 is allowable because there is no double patenting between claim 79 and U.S. Patent No. 6,281,990.

Claims 68-70 are allowable for the following reasons:

Claim 68 recites suppressing a memory range of storage of a portion of the image data that corresponds to a portion of the edge section in a side of the pages of the book being read. This feature in combination with other limitations of claim 68 is not taught by the prior art of record.

Claim 69 claims a specific storing step for storing image data corresponding to a different specific size of a plurality of book pages in two different cases. This feature in combination with other limitations of claim 69 is not taught by the prior art of record.

In claim 70, the feature of deciding a start point for storing image data of the spread of book pages according to the result of detecting a position of a page edge section in the spread book pages, in combination with other limitations of claim 70 is not taught by the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
September 29, 2004

A handwritten signature in black ink, appearing to read "Cheukfan Lee", is positioned to the right of the typed name and date.